

**REMARKS/ARGUMENTS**

In response to the Office Action dated March 28, 2005, claims 15 and 21 are amended. Claims 1, 2, 4-16 and 18-22 are now active in this application. No new matter has been added.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103**

I. Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as being anticipated by Stephenson (USPN 5,757,388).

Claims 4-9 and 11-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Yokoyama (USPN 5,694,226).

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Yokoyama and Kawai et al. (USPN 5,805,780).

Claims 4-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Amoni et al. (USPN 5,884,086)

Claims 15, 16 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Amoni et al., Kawai et al. and *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Amoni et al., Kawai et al., *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965), and Meese et al.

Claims 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Amoni et al., Kawai et al. and Meese et al.

The rejections are respectfully traversed.

II. The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

A. Independent claim 1 delineates that:

... the detecting unit including  
a connector configured to receive a plug of a cable attached to the external device, and  
an interface controller connected to the connector, the interface controller outputting a first logical level signal when the plug is inserted into the connector and outputting a second logical level signal when the plug is not inserted into the connector;  
a printing unit; and  
a control unit for controlling, in response to the first logical level signal output by the interface controller, the printing unit so as to prepare for image forming according to the image data from the external device.

None of the applied prior art references discloses or suggests the features recited in independent claim 1, and in particular, an interface controller that output a first logical level signal when the plug is inserted into the connector and outputting a second logical level signal when the plug is not inserted into the connector.

The Examiner, however, maintains that Stephenson discloses a detecting unit at 30 in FIG. 2 and that it includes a connector (24) configured to receive a plug of a cable attached to the external device (column 2, lines 54-58), and an interface controller (26) connected to the connector, the interface controller outputting a first logical level signal when the plug is inserted into the connector and outputting a second logical level signal when the plug is not inserted into the connector (column 2, lines 60-63). With this interpretation, the Examiner asserts that “In

order to establish a physical and electrical connection between the camera and the printer, a plug of some sort of cable must be received. Otherwise, there can be no electrical connection. In order to selectively secure and release the ink jet printer under control of the printer electronics, two separate logical level signals are inherent, ...”

However, such inherency is merely speculative since activation of latch driver 26 to secure activate latch 24 of the ink jet printer 12 to the active socket 20 of electronic camera 10 does not entail logical level signals as latch driver 26 cannot be realistically considered to be an interface controller that can output such logical level signals to printer electronics 30. The disclosure in Stephenson regarding printer electronics 30 is as follows:

Column 3, lines 23-28:

...The ink jet print head 45 is selectively driven by printer electronics 30 so as to form a strip of printed image. The printer electronics 30 can conveniently receive image information from the camera electronics 16 which includes a storage unit as previously discussed. However, in accordance with the present invention, the printer electronics 30 can also be directly coupled to the camera display 18 using printer receiver device 32, discussed hereinafter.

Column 3, lines 44-52:

...The operator signals the start of printing using printer electronics 30. The printer's active socket 20 signals the camera electronics 16 to indicate that it is in the condition for transferring images to the ink jet printer 12 using camera display 18. Upon print initialization, electronic camera 10 selectively modulates camera display 18 so as to communicate with printer receiver device 32. The printer electronics 30 and the camera electronics 16 are designed to optimize data transmission

Column 4, lines 9-21:

...Alternatively all or a large subset of the image can be transferred to memory elements in printer electronics 30 prior to the beginning of dye deposition.

The use of the latch driver 26 under the control of printer electronics 30 ensures that ink jet printer 12 is not detached from electronic camera 10 during image transmission from camera display 18 and printer receiver device 32. An

operator detaches ink jet printer 12 from electronic camera 10 using an interface to printer electronics 30 such as a conventional switch. Printer electronics 30 then activates latch driver 26 to permit removal of ink jet printer 12 from camera 10.

Nowhere in these description portions is there anything described regarding logical level signals. Since latch drive 26 is **NOT** required to output a first logical level signal **to** printer electronics 30 when the ink jet printer 12 is secured to the camera 10 as well as to output a second logical level signal **to** printer electronics 30 when the ink jet printer 12 is released from the camera 10, it is incorrect to assert that "In order to selectively secure and release the ink jet printer under control of the printer electronics, two separate logical level signals are inherent, ..."

The above argued differences between the claimed device vis-à-vis the device of Stephenson undermine the factual determination that Stephenson identically describes the claimed inventions within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Stephenson is not factually or legally viable and, hence, solicit withdrawal thereof.

Independent claims 2, 8 and 11 all similarly recite the feature of an interface controller that output a first logical level signal when the plug is inserted into the connector and outputting a second logical level signal when the plug is not inserted into the connector and the Examiner interprets Stephenson similarly with respect to independent claims 2, 8 and 11.

Furthermore, Stephenson discloses that an image forming apparatus obtains image data from an external device by a printer receiver device 32 reading image data output to a display 18 of the camera. In contrast, in the present invention, image data is sent from the external device

to the image forming apparatus via the cable that is connected to the external device (e.g., claim 1, “a connector configured to receive a plug of *a cable attached to the external device*”). To expedite prosecution, independent claims 1, 2, 8 and 11 are amended to delineate that “the image data is set from the external device to the image forming apparatus via the cable,” which further distinguish over the arrangement of Stephenson.

In addition, claim 11 is amended to delete “via the connector” from the recitation “an external device detecting unit for detecting whether the external device has been connected to the image forming apparatus ~~via the connector~~,...”

Thus, in view of the above, amended independent claims 1, 2, 8, 11, as well as dependent claims 4-7, 9, 10 and 12-14, are patentable over Stephenson, considered alone or in combination with the other applied prior art references and their allowance is respectfully solicited.

**B.** The invention recited in independent claims 15 and 21 includes a collecting *a charge for an amount of power that has been supplied to the external device*, as well as a charge for the image forming. The Examiner relies upon Kawai as disclosing a charge collecting unit 8 (column 5, lines 54-55) for collecting a charge for the operation of the image forming apparatus. In this regard, the Examiner further asserts “That operation of the apparatus includes both forming the image and supplying the power to operate the necessary components. Furthermore, the charge collecting unit performs the function of a judging unit for judging whether a charge is to be collected.”

Kawai et al. is directed to a photographing box arranged to reduce a time taken from photographing an object to printing the image of the object. While money handling machine 8 operates to send a start signal to the controller 7 when a user gives a proper fee by cash or pre-

paid card, there is nothing in Kawai et al. which can reasonably be interpreted as disclosing *both* a charge for the image forming and a charge for an amount of the power that has been supplied to the external device are collected. This is true even if Kawai et al. discloses that the power supply 10 operates to feed power to (those) components (column 6, lines 6-7), as there is nothing in the reference that there should be a separate charge collected for an amount of the power that has been supplied *to the external device* ( the camera 4).

Thus, independent claims 15 and 21, as well dependent claims 16, 18, 19 and 22, are patentable over Stephenson, considered alone or in combination with Amoni et al., Kawai et al. and Meese et al.

At any rate, independent claim 15 is amended to require, *inter alia*:

a charge collecting unit for collecting a charge for the image forming and a charge, separate from the charge for the image forming, for an amount of the power that has been supplied to the external device

Independent claim 21 is similarly amended. Thus, it is believe clear that in independent claims 15 and 21, a charge for the power supplied to the external device is collected if power is supplied without image forming being performed, whereas a charge for image forming is collected if image forming is performed without power being supplied.

Consequently, the allowance of independent claims 15 and 21, as amended, as well as dependent claims 16, 18, 29 and 22 is respectfully solicited.

With regard to independent claim 20, Stephenson is directed to an electric camera and integral ink jet printer, Amoni et al. is directed to a data processing system, such as a personal computer, wherein non-standard, or auxiliary voltage and current may be supplied to an attached peripheral device along with standard USP power and signaling, and Kawai et al. is directed to a

photographing box arranged to reduce a time taken from photographing an object to printing the image of the object.

However, Meese et al. relates to *a charging meter and method for electric vehicles*, permitting charging of an electric vehicle at a parking location in response to use of a charge card and storing charging and parking information for subsequent retrieval to facilitate billing to the owner of the charge card. In contrast, the present invention is directed to an image forming apparatus that includes a charge collecting unit for collecting a charge for an amount of power that has been supplied to an external device connected to the image forming apparatus.

Clearly, Meese et al. is directed to a nonanalogous art as that of the other applied references, as well as that of the claimed invention. *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992); *Ex parte Dussaud*, 7 USPQ2d 1818 (BPAI 1988). Accordingly, it cannot be said that one having ordinary skill in the relevant art would have been charged with knowledge of Meese et al.. Thus, the requisite motivation required to establish a *prima facie* case of obviousness is nonexistent.

Thus, independent claim 20 is patentable over Stephenson, considered alone or in combination with Amoni et al., Kawai et al. and Meese et al., and its allowance is respectfully solicited.

### **NEW CLAIM**

New claim 23 is submitted and is derived from previously amended claim 15. More specifically, new claim 23 recites:

An image forming apparatus, comprising:  
a power supplying unit for generating power that is to be supplied to an external device transmitting image data;  
an interface for connecting the external device to the image forming apparatus, wherein the image data from the external device is received via the

interface and the power from the power supplying unit is supplied to the external device via the interface;

a judging unit for judging whether a charge is to be collected;

a printing unit;

a control unit for controlling power supplying by the power supplying unit and image forming by the printing unit according to a judging result from the judging unit, wherein the control unit has the printing unit form an image according to the image data from the external device that has been received via the interface; and

a charge collecting unit for collecting a charge for the image forming and a charge for an amount of the power that has been supplied to the external device, wherein

*a charge for image forming is collected if image forming is performed without power being supplied to the external device, and*

*a charge for the amount of power that has been supplied to the external device is collected if power is supplied to the external device without image forming being performed by the image forming apparatus. (Emphasis added)*

Kawai et al. does not disclose or suggest that a charge for image forming is collected if image forming is performed without power being supplied to the external device, and a charge for the amount of power that has been supplied to the external device is collected if power is supplied to the external device without image forming being performed by the image forming apparatus. Thus, claim 23 is patentable over Stephenson, Amoni et al. and Kawai et al., considered alone or in combination. Consequently, the allowance of claim 23 is respectfully solicited.

## **CONCLUSION**

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

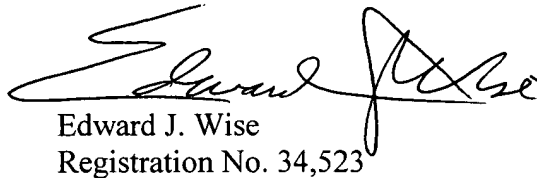


**Application No.: 09/585,339**

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Edward J. Wise  
Registration No. 34,523

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 EJW:cac  
Facsimile: 202.756.8087  
**Date: June 28, 2005**

**Please recognize our Customer No. 20277  
as our correspondence address.**